

REMARKS

Claims 1, 3-8, and 26-28 are currently pending. The Examiner indicated that the traversal was not found to be persuasive and has removed Claim 28 from consideration as being drawn to a nonelected invention. In an Office Action mailed October 6, 2003, the Examiner raised a number of issues, listed below in the order they are addressed herein:

- 1) The Information Disclosure Statement has not been considered because the references are allegedly lacking;
- 2) Claims 6-8 are rejected under 35 USC § 101, as allegedly directed to non-statutory subject matter;
- 3) Claims 1, 3-8, 26, and 27 are rejected under 35 USC § 112, first paragraph, as allegedly failing to convey that inventors had possession of the claimed invention;
- 4) Claims 1, 3-8, 26, and 27 are rejected under 35 USC § 112, first paragraph, as allegedly failing to provide sufficient enablement;
- 5) Claims 7 and 8 are rejected under 35 USC § 112, second paragraph, as allegedly indefinite; and
- 6) Claim 8 is rejected under 35 USC § 102(e), as allegedly anticipated by Elliott *et al.* (U.S. Patent No. 5,837,489).

Applicants have amended Claims 1, 5, 6, and 7, added new Claims 29 and 30, and canceled Claims 3, 4, 8, and 26-28, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader claims in one or more future application(s). These amendments do not introduce new matter and are not intended to narrow the scope of any of the claims within the meaning of *Festo*.¹

1) The Information Disclosure Statement Is Proper

The Examiner states that "[t]he information disclosure statement filed 4/2/99 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

or that portion which caused it to be listed" (Office Action, page 3). Applicants *strongly* disagree that the Information Disclosure Statement (IDS) submitted by Applicants is improper. All 209 references listed on the IDS were submitted with the IDS and Form PTO-1449 on 4/2/99. In addition, in a May 2002 teleconference between the Examiner's supervisor (Gary Kunz) and Applicants' representative (Christine Lekutis), Supervisor Kunz suggested that Applicants reconstitute the Application as it had apparently been lost for a period of time beginning on or after October 1999. For this reason, Applicants resubmitted all correspondence including copies of the IDS, Form PTO-1449 and the 209 references cited therein, to the attention of Gary Kunz via Federal Express EV 008 740 949 US and EV 008 740 952 US on June 25, 2003. Copies of Form PTO-1449 are included herein for the Examiner's convenience along with Federal Express tracking information and the return receipt postcard indicating receipt of this material by Technology Center 1600 (attached herein at Tab A). Applicants *strongly* encourage the Examiner to immediately take steps to locate either the original or the resubmitted references and to consider the references before mailing a Notice of Allowance or second substantive Office Action.

2) The Claims Are Directed to Patentable Subject Matter

The Examiner has rejected Claims 6-8 under 35 USC § 101, as allegedly directed to non-statutory subject matter. Specifically the Examiner states that the claims as written encompass embodiments that do not involve the hand of man (Office Action, pages 3 and 4). Accordingly, Applicants have amended Claim 6 and canceled Claim 8, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). At the Examiner's suggestion, Applicants have amended Claim 6 to recite an "isolated host cell." As the claims are directed to patentable subject matter, Applicants respectfully request that this rejection be withdrawn.

3) The Claims Meet the Written Description Requirement

The Examiner has rejected Claims 1, 3-8, 26 and 27 under 35 USC § 112, first paragraph, as allegedly failing to convey that inventors had possession of the claimed

invention. Applicants must respectfully disagree. Nonetheless, Applicants have amended Claim 1 and canceled Claim 8, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). At the Examiner's suggestion, Applicants have amended Claim 1 to recite an "isolated nucleotide sequence consisting of...nucleotides 1-392 of SEQ ID NO:94." Applicants believe this amendment should obviate the Examiner's rejection.

4) The Claims Are Enabled

The Examiner has rejected Claims 1, 3-8, 26, and 27 are rejected under 35 USC § 112, first paragraph, as allegedly failing to provide sufficient enablement. Applicants must respectfully disagree. Nonetheless, Applicants have amended Claim 1, added new Claims 29 and 30, and canceled Claims 3, 4, 8, and 26-28, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). At the Examiner's suggestion, Applicants have amended Claim 1 to recite an "isolated nucleotide sequence consisting of...nucleotides 1-392 of SEQ ID NO:94." In addition, Applicants have rewritten canceled Claims 27 and 28 as independent Claims 29 and 30 to recite an "isolated nucleotide sequence consisting of...nucleotides 1-447 of SEQ ID NO:94," and an "isolated nucleotide sequence consisting of...nucleotides 1-457 of SEQ ID NO:94," respectively. Applicants believe these amendments should obviate the Examiner's rejection.

5) The Claims Are Definite

The Examiner has rejected Claims 7 and 8, under 35 USC § 112, second paragraph, as allegedly indefinite. Applicants must respectfully disagree. Nonetheless, Applicants have amended Claim 7 and canceled Claim 8, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). In particular, the Examiner states that there is no proper antecedent basis for "said cell," and suggests amending the Markush group. Accordingly,

Applicants have amended Claim 7 to recite an "a bacterial cell, a yeast cell, an amphibian cell and a mammalian cell." Applicants believe this amendment should obviate the Examiner's rejection.

6) The Claims Are Novel

The Examiner has rejected Claim 8 under 35 USC § 102(e), as allegedly anticipated by Elliott *et al.* (U.S. Patent No. 5,837,489). Applicants must respectfully disagree. Nonetheless, Applicants have amended Claim 7, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s).

CONCLUSION

Applicants respectfully request that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

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Christine A. Lekutis
Registration No. 51,934

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415.904.6500